

### REMARKS

Claims 163-167, 170-171, 173-180, 182-188, 190-195, 197-198, and 200-210 constitute the pending claims in the present application. Claims 1-162, 168-169, 172, 181, 189, 196, and 199 were previously cancelled. No claims are cancelled herein. Claims 163-167, 170-171, 173-174, 203, and 207 stand rejected. Claims 175-180, 182-188, 190-195, 197-198, 200-202, 204-206, and 208-210 are allowed. A listing of the pending claims has been provided solely for the convenience of the Office.

Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Office are addressed below in the order they appear in the prior Office Action.

#### Claim Rejections – 35 U.S.C. 102(a) – Claren

Claims 163, 173-174, and 207 are rejected under 35 U.S.C. 102(a) as allegedly being anticipated by U.S. 5,899,909 to Claren et al. (“Claren”). Without commenting on the merits of the rejection, Applicants respectfully highlight that Claren is not properly prior art under 102(a). As noted by the Office, 102(a) requires that “the invention was ... patented or described in a patent publication ... before the invention thereof by the applicant for patent” (emphasis added). Claren was granted for patent on **May 4, 1999** and was filed **February 25, 1997**. In contrast, the instant application claims priority to U.S. Provisional Application 60/038,171, filed **February 13, 1997** (“the Provisional Application”), which predates not only the Claren date of grant but also the Claren filing date, so Claren itself cannot be prior art under 102(a). Applicants note that the instantly claimed subject matter is fully supported by the Provisional Application.

In order to advance prosecution, Applicants highlight that Claren also cannot support a rejection under 35 U.S.C. 102(e). Although the face of the Claren patent notes that it claims priority to two Swedish applications, SE 9402872, filed August 30, 1994 (“SE ‘94”) and SE 9503512, filed October 9, 1995 (“SE ‘95”), Applicants note that the Certificate of Correction issued in Claren states that the application is a “national stage filing” of two PCT applications (although there is no reference to 35 U.S.C. 371), namely PCT/SE95/00946, filed August 25, 1995 (“PCT ‘95”) and PCT/SE96/01269, filed October 8, 1996 (“PCT ‘96”). PCT ‘95 claims priority to SE ‘94, and PCT ‘96 claims priority to SE ‘95. Assuming Claren validly claims priority to both PCT ‘95 and

PCT '96 (although Applicants do not concede this), Applicants note that both PCT '95 and PCT '96 were filed before November 29, 2000, and so the provisions of 35 U.S.C. 102 and 374, prior to the AIPA amendments are applicable. *See* MPEP 706.02(f)(1)(I)(C)(3)(a). According to these provisions, PCT '95 and PCT '96 would only be eligible to be 102(e) prior art “as of the earlier of the date of completion of the requirements of 35 U.S.C. 371(c)(1), (2), and (4) or the filing date of the later-filed U.S. application that claimed the benefit of the international application” (i.e., of Claren). In the instant case, the Claren filing date, **February 25, 1997**, is the earlier of the two dates (assuming a valid 371(c) date is even applicable). As noted above, this date is after the filing of the Provisional Application, and so Claren cannot be 102(e) prior art against the present application.

Regarding PCT '95 and PCT '96 themselves, which Applicants cited in the Supplemental IDS's dated September 20, 2004 and October 3, 2006, respectively, Applicants note that PCT '95 was published as WO 96/06567 on **March 7, 1996**, and PCT '96 was published as WO 97/13465 on **April 17, 1997**. For PCT '95, the published application does not teach or suggest the “sheath or pouch (34)” feature found in Claren, and so cannot support the instant rejection of claim 163 or those dependent thereon. For PCT '96, this application was published after the filing date of the Provisional Application and is thus not prior art under 102(a) or 102(b).

The same analysis holds for the priority documents of PCT '95 and PCT '96, namely SE '94 and SE '95, respectively. In the interest of expediting prosecution, Applicants have also cited these Swedish applications in the co-filed Supplemental Information Disclosure Statement and provided copies of the *best available* abstracts. As can be seen, SE '94 was purportedly made available to public viewing on **March 1, 1996** (INID code # 41, see <http://www.bpmlegal.com/howtopat2.html> for code descriptions). However, like PCT '95, this application does not include the “sheath or pouch (34)” feature found in Claren. Accordingly, this application does not anticipate pending claim 163 or those dependent thereon. Regarding SE '95, this application has **April 10, 1997** as the date it was made available to public viewing, which is after the filing date of the Provisional Application. Accordingly, SE '95 is not valid prior art under 102(a) or 102(b).

For the above reasons, Applicants submit that the instant anticipation rejection over Claren is improper since this reference is not valid prior art. Applicants also submit that any of the references in Claren's purported priority chain are also either not valid prior art or do not support the rejection. Accordingly, Applicants request reconsideration and withdrawal of the rejection.

*Claim Rejections – 35 U.S.C. 103(a) – Claren in View of Totakura*

Claims 163-167, 170-171, 173-174, 203, and 207 are rejected under 35 U.S.C. 103(a) as allegedly being obvious over U.S. Patent No. 5,439,467 to Benderev et al ("Benderev") in view of Norris et al. "Use of Synthetic Material in Sling Surgery: A Minimally Invasive Approach" ("Norris") and Claren. Applicants respectfully traverse the rejection and note above that Claren is not proper prior art under 35 U.S.C. 102(a) or (e). As acknowledged by the Office, Benderev and Norris do not teach at least "the use of a pouch over a portion of the sling assembly," and the Office relies on Claren to satisfy the pouch feature recited in claim 163. Since Benderev and Norris either alone or in combination have not been shown to render claim 163 obvious, Applicants request reconsideration and withdrawal of the rejection.

*Allowed Claims*

Applicants note with appreciation that claims 175-180, 182-188, 190-195, 197-198, 200-202, 204-206, and 208-210 are in condition for allowance. Applicants submit that none of the remarks herein should alter the Office's conclusion of allowability for these claims.

*Withdrawal of Prior Rejections of Record*

Applicants note with appreciation the withdrawal of prior rejections of record under 35 U.S.C. 112, first paragraph and 35 U.S.C. 103(a) over various combinations of Benderev, Norris, and U.S. Patent No. 3,580,256 to Wilkinson et al.

**CONCLUSION**

In view of the above arguments and amendments, Applicants believe the pending application is in condition for allowance. Applicants believe no fee beyond that required for the above-mentioned co-filed Supplemental Information Disclosure Statement is due with this response.


Reply dated June 22, 2009  
In Reply to Office Action of April 28, 2009

Application No.: 10/774,826  
Docket No.: MIY-P03-006

However, if any additional fee is due, please charge our Deposit Account No. 18-1945, under Order No. MIY-P03-006 from which the undersigned is authorized to draw.

Dated: June 22, 2009

Respectfully submitted,

By   
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